

## REMARKS

In the Office Action mailed June 27, 2008, the Office Action noted that claims 1-18 and 65-67 were pending, rejected claims 1-18, 65 and 66 and withdrew claim 67 from consideration as being directed to a non-elected invention. Claims 1, 7, 65, and 66 have been amended;; and thus in view of the foregoing, claims 1-18 and 65-67 remain pending for reconsideration which is requested. No new matter is believed to be added. The rejections are respectfully traversed below.

### **Request to Withdraw Constructive Election/Restriction**

The Office Action, on pages 17-18, constructively elected claims 1-18 and 65-66 for prosecution on the merits and withdrew claim 67 from consideration as being directed to a non-elected invention. Particularly, the Office Action asserted the claim 67 "has separate utility such as notifying the customer that the customer did not pick up the good on a day of pick up when the seller does not receive a transfer-completion notification from the delivery destination during a pick-up time window." However, it is submitted that the assertion by the Office Action is incorrect.

According to MPEP § 821.03, if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144. However, in this case, claim 67 is neither independent nor distinct from the previously presented claims. According to MPEP § 802.01, the term "independent" means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. See also MPEP § 806.06 and § 808.01.

Claim 1 recites "warning the customer that the customer does not receive the commodity when the seller's terminal does not receive a transfer-completion notification from the receiver certifying terminal in a predetermined term."

Claim 67 recites: "notifying the customer that the customer did not pick up the good on a day of pick up when the seller does not receive a transfer-completion notification from the delivery destination during a pick-up time window."

In the present Application, the claim language quoted above in originally submitted claim 1 and previously submitted 67 is not "distinct and independent of the invention previously claimed." As recited in both claims, notification or warning occurs when the customer has failed to obtain the commodity or good ordered and is being contacted because the seller did not receive a "transfer-completion notification" in a "predetermined term" or a "pick-up time window." While claim 1 recites "a predetermined term," claim 67 recites "a pick-up time window" which is not distinct or independent.

According to MPEP § 802.01, related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.

Here, both claims recite similar claim language which describes a similar operation of reminding the customer to pick up the good ordered if the seller has not received "a transfer-completion notification." Both claims are based upon page 37, line 23 – page 38, line 24 of the originally filed specification. Thus, it is submitted that the assertion by the Office Action is incorrect.

Withdrawal of the constructive election/restriction is respectfully requested.

#### **Rejection of Claims 1, 65 and 66 Under 35 U.S.C. §112**

On page 3 of the Office Action, claims 1, 65 and 66 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action alleges that "when the receiver certifying information is identical to the reference receiver certifying information, by using said transaction ID information and the receiver certifying information or the reference receiver certifying information" recited in claim 1 and 65, and "transferring the commodity to a receiver for the commodity when the first piece of receiver certifying information corresponds to the second piece of receiver certifying information" recited in amended claim 66 are not supported in the specification. However, the Examiner is respectfully requested to reference line 9, page 31 to line 19 of page 32 of the originally filed specification. Withdrawal of the rejection is requested.

In addition, the Office Action alleges that "warning the customer that the customer does not receive the commodity when the seller's terminal does not receive a transfer-completion notification from the receiver certifying terminal in a predetermined term" recited in claim 1, and

“at the seller’s terminal warning the customer, that the customer does not receive the commodity when the seller’s terminal does not receive a transfer-completion notification from the receiver certifying terminal in a predetermined term” recited in amended claim 65 and amended claim 66 are not supported in the specification. This claimed feature is referred to throughout the originally filed specification and as the “do-not-forget warning.” In addition, the Examiner is respectfully requested to reference page 37, line 23 – page 38, line 24 of the originally filed specification.

Finally, claims 1, 65, and 66 have been amended. Accordingly, withdrawal of the rejection is respectfully requested.

**Rejection of Claims 1-6, 10-13, 15, 65 and 66 Under 35 U.S.C. §103(a)**

On page 4 of the Office Action, claims 1-6, 10-13, 15, 65 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shub et al. (U.S. Patent No. 6,807,530), in view of Stolfo et al. (U.S. Patent No. 7,069,249), and further in view of Camp et al. (U.S. Patent No. 6,076,078). This rejection is respectfully traversed.

Claim 1 is directed to a method of e-commerce having a seller, a customer, a payment agent, and a delivery mechanism which allows for anonymous transactions via the web. Personal information of the customer such as name, address, telephone number, and goods purchased which provide a customer’s personal preferences are kept from the seller. (see Abstract). In addition, the method in claim 1 protects the customer by “warning the customer that the customer does not receive the commodity when the seller’s terminal does not receive a transfer-completion notification from the receiver certifying terminal in a predetermined term.” (See claim 1 and page 37, line 23 – page 38, line 24 of the originally filed specification as noted above).

It is respectfully submitted that Shub, Stolfo, and Camp, either alone or in combination, fails to teach or suggest the claimed:

warning the customer that the customer does not receive the commodity when the seller’s terminal does not receive a transfer-completion notification from the receiver certifying terminal in a predetermined term.

On page 7 of the Office Action, it is admitted that the combination of Shub and Stolfo does not teach the above recited features of claim 1. But, the Office Action then alleges that Stolfo “does teach messages within its Webpage to remind and direct the user to take certain actions from the second party vendor and may provide a final message asking whether all information of the screen is correct.” In addition, the Office Action alleges that the above claimed features are

taught in Camp in col. 13, lines 53-59 and col. 16, lines 7-22. However, Camp is directed to purchases of digital goods and acknowledges that the disclosure “is optimized for information goods delivered online” (see col. 5, lines 15-16 and Abstract). Camp describes methods to make atomic transactions anonymous and the various problems related to when “the network or merchant server goes down during a purchase.” (See col. 1, lines 63-67). The Office Action cited col. 16, lines 13-15 of Camp which state: “If the **customer fails to produce message E5** sufficiently fast, the merchant may force the transaction to commit by sending both messages E4 and E6 to the archive.” In other words, Camp describes a method that requires **the customer to respond to the merchant**, nearly simultaneously during a purchase of a digital good, or else the transaction may commit. However, as claimed in amended claim 1, the customer is warned that a commodity which is to be sent to a physical address or “a non-residential place” is delayed **without any input on behalf of the customer**. If the customer had to respond to such a warning before receiving the warning, the customer may never receive the commodity. In addition, one of ordinary skill in the art would understand that Camp, which is refers to delivery of “messages” and digital goods is not applicable to delivering a physical “commodity” “to a non-residential place.” Thus, one of ordinary skill in the art would not be inclined to combine the teachings of Camp with Shub and Stolfo, and thus, it is submitted that claim 1 is patentably distinguishable over Shub, in view of Stolfo and further in view of Camp for the reasons discussed above.

In addition, none of the above references disclose:

sending an anonymous order to the seller’s terminal for a commodity via the information communication network and designating a non-residential place other than a residential place of the customer as the delivery destination via the information communication network, **said anonymous order being void of personal identification information**

Shub discusses a method and apparatus for remote commerce which “enables customers to remotely order goods from a merchant and receive the goods without revealing the customer’s identity or address.” (See col. 1, lines 5-13). This method of remote commerce is not “anonymous” because the merchant knows what the customer has purchased in the past and **even knows the customer’s zip code**. (See col. 2, lines 57-59). On the contrary, claim 1 is directed to an e-commerce method of processing “**an anonymous order ...being void of personal identification information**” including past sales, which can provide “a consumer’s preference, thought, and belief” as well as a friend’s preferences if gifts for friends have been purchased. (See line 18, page 4 to line 21, page 5 of the originally filed specification). Thus,

according to the present Application and as recited in claim 1 **the seller does not know what the buyer has purchased in the past**. Nothing has been cited or found in Stolfo or Camp that cures the deficiencies of Shub discussed above.

For instance, one of ordinary skill in the art would not combine the teachings found in Stolfo with Shub to cure these deficiencies. Stolfo states: "It is another object of the invention to provide a system to **gather information** about electronic transactions and purchases that does not include private and personal information of purchasers, but **includes other information about the transaction, including information about the good, its price, and the identity of the electronic vendor.**" (See Stolfo, col. 6, lines 25-32). While claim 1 is related to preventing the dissemination of "personal identification information" including goods purchased, **Stolfo discusses the exact opposite**. Thus, it is submitted that independent claim 1 is also patentably distinguishable over Shub in view of Stolfo and further in view of Camp, as neither Shub, Stolfo nor Camp, either alone or in combination, teaches or suggests the above identified features of claim 1. It is also respectfully submitted that independent claims 65 and 66 are also patentably distinguishable for these same reasons.

In addition, dependent claims 2-6, 10-13 and 15, which depend from claim 1, are patentably distinguishable over the cited references. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 11 recites "upon completion of delivery of the commodity to said non-residential place by said commodity delivering, **the seller's terminal notifies the customer's terminal of the completion of delivery of the commodity via the information communication network.**" In particular, the cited references do not teach the above claimed features found in claim 11. Thus, it is submitted that the dependent claims are independently patentable over the cited references.

#### **Rejection of Claims 7-8 Under 35 U.S.C. §103(a)**

On page 15 of the Office Action, claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shub, Stolfo, Camp and further in view of Shkedy (U.S. Patent No. 6,236,972). For reasons similar to those found above, it is submitted that dependent claims 7 and 8, which depend from claim 1, are patentably distinguishable over Shub, Stolfo, Camp, and Shkedy.

#### **Rejection of Claim 9 Under 35 U.S.C. §103(a)**

On page 16 of the Office Action, claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shub, Stolfo, Camp, and further in view of Tsukeda (U.S. Patent No.

6,085,170). For the reasons above, it is submitted that dependent claim 9, which depends from claim 1, is patentably distinguishable over Shub, Stolfo, Camp, and Tsukeda.

**Rejection of Claim 14 Under 35 U.S.C. §103(a)**

On page 16 of the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shub, Stolfo, Camp, and further in view of O'Leary (U.S. Patent No. 6,609,113). For the reasons above, it is submitted that dependent claim 14, which depends from claim 1, is patentably distinguishable over Shub, Stolfo, Camp, and O'Leary.

**Rejection of Claims 16-18 Under 35 U.S.C. §103(a)**

On page 17 of the Office Action, claims 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shub, Stolfo, Camp, and further in view of Quinlan et al. (U.S. Patent No. 6,748,365). For the reasons above, it is submitted that dependent claims 16-18, which depends from claim 1, are patentably distinguishable over Shub, Stolfo, Camp, and Quinlan.

**Summary**

In accordance with the foregoing, claims 1, 7, 65 and 66 have been amended. Claims 1-18 and 65-67 are pending and under consideration. In view of the foregoing amendments and remarks, it is respectfully submitted that each of the claims patentably distinguishes over the cited references, and therefore, defines allowable subject matter. A prompt and favorable reconsideration of the rejection along with an indication of allowability of all pending claims are therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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9/29/8

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